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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,241

01/19/2006

Walter Kuhn

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03/13/2009

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EXAMINER

GRESO, AARON J

ART UNIT

PAPER NUMBER

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/565,241	Applicant(s) KUHN ET AL.	
	Examiner AARON GRESO	Art Unit 1796	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/09/2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 9-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 9-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office Action is in response to the Amendments filed 02-09-2009. In the correspondence of 02-09-09, Claims 3 and 8 are canceled. Claims 1, 7, and 9-18 were amended to further limit the genus of Claim 1 and to remediate 35 U.S.C. §112 rejections.

Response to Arguments

Discussions concerning Examiners Claim Rejections refer to the previous action and references therein, dated 11/12/2008.

Claim Rejections - 35 USC § 102 and USC § 112

Regarding Claims rejected under USC 35 § 102 and 112: Corrections have been made by applicant; rejections are withdrawn.

Claim Rejections - 35 USC § 103

Applicant's arguments filed 02/09/2009 have been fully considered but they are not persuasive. The 35 USC § 103 rejections stand.

Regarding Claims 1-2, 5-6, 10 and 19-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Rohde et al.* (WO 01/43784):

Applicants note that *Rhode et al.* disclose a genus of compounds that are useful as odor neutralizers and that *Rode et al.* esters have a slight odor. Applicants' arguments contend that *Rhode et al.* teach away from the Applicants' Claims.

In response to applicant's argument that *Rhode et al.* teach away when disclosing chemicals that include those of the Applicants, that have a slight odor when taught along with odors of other chemicals not in the genus, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention (a chemical structure) and the prior art (chemical structure) in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, *Rode et al.* cite 3,3,5 esters in the reference's disclosure (page 19 lines 18-21). These chemicals would be expected to be present in one of three arrangements: either cis or trans or both. The Applicants' comparisons of chemical odor superiority are only between cis and trans chemicals within the same enantiomer genus.

The Applicants arguments are not commensurate with the scope of the Claims and are not found persuasive; the rejections stand.

Regarding rejections for Claims 1-2, 5-6, 10 and 19-23 under 35 U.S.C. 103(a) as being unpatentable over *Burrell et al.* (US 5306707):

Applicants note that *Burell et al.* disclose compounds that are useful preservatives that provide fresh odors. Applicants' arguments contend that *Burrell et al.* fail to disclose or suggest use of the fragrances in the newly amended Claims.

The Examiner disagrees. *Burell et al.* (Abstract) disclose fragrances that also perform as preservatives. Use of these chemicals enables a fresh aroma. The chemical genus claimed by *Burell et al.* (col lines 57-68) encompasses those chemicals

claimed by the Applicant. *Burrell et al.* therefore suggest using the Applicants' chemicals, which are part of the genus, to provide for fresh fragrances as claimed by the Applicant. These chemicals would be expected to be present in one of three arrangements: either cis or trans or both.

The Applicants arguments are not commensurate with the scope of the claims and are not found persuasive; the rejections stand.

Regarding rejections for Claims 4, 7,9, 11-14, 17-18 under 35 U.S.C. 103(a) as being unpatentable over *Rohde et al.* (WO 01/43784) as applied to Claims 1-2, 5-6, and 10 above, and in and further view *Burrell et al.* (US 5306707):

Applicants note that *Rode et al.* in view of *Burrell et al.* disclose compounds that are useful preservatives and odor neutralizers that together would prevent fragrance degradation while allowing for a fragrance to be fresher. Applicants' arguments contend that *Rhode et al.* in view of *Burrell et al.* fails to fully disclose information to make the Applicants' Claims obvious.

In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Rhode et al. and *Burrell et al.*, when taken together, suggest using the Applicants' chemicals, named by the *Rhode et al.*, to provide for fresher fragrances as suggested

by the Genus of *Burell et al.*; these include those claimed by the Applicant. These chemicals would be expected to be present in one of three arrangements: either cis or trans or both.

The Applicants arguments are not commensurate with the scope of the claims and are not found persuasive; the rejections stand.

Regarding rejections for Claims 1-2, 9, 11-16, 17-18 under 35 U.S.C. 103(a) as obvious over *Morelli et al.* (US 6087322):

Applicants note that *Morelli et al.* discloses a genus of compounds that the Examiner indicates can produce chemicals of the type claimed by the Applicants. Applicants' arguments contend that *Morelli et al.* fails to disclose or suggest use of cis esters in combination with trans esters.

Furthermore, Applicants argue that neither *Burell et al.* nor *Rode et al.* specifically disclose use of cis-esters in combination with trans-esters. The Applicants further argue that neither *Burell et al.*, *Rode et al.* nor *Morelli et al.* disclose that cis isomers are superior olfactory fragrances over trans-isomers nor do *Burell et al.*, *Rode et al.* nor *Morelli et al.* disclose that mixtures of cis and trans isomers result in superior fragrances.

In response to these related alleging arguments, that that the references fail to show certain features of applicant's invention, it is noted that the features upon which Applicant relies (i.e., superiority of cis over trans fragrances or the cis/trans mixture superiority) are not recited in the rejected claim(s). Although the claims are interpreted

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in light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The genus's disclosed by *Morelli et al.*, *Rhode et al.*, and *Burell et al.*, all encompass the structures claimed by the Applicants. These disclosed chemicals can be used commensurate with the Applicants' Claims.

The Applicants arguments are not commensurate with the scope of the claims and are not found persuasive; the rejections stand.

It is also the Examiner's position that 1) adjusting or varying the amounts of fragrances, with inherent olfactory notes or properties, to arrive at 2) desired fragrance types or scents are result effective variables because changing them will clearly affect the type of product obtained. See MPEP § 2144.05 (B). Case law holds that "discovery of an optimum value of a result effective variable in a known process is ordinarily within the skill of the art." See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

In view of the Examiner's arguments above, it would have been obvious to one of ordinary skill in the art to utilize appropriate blending optimization skills, common to those making various perfumes, including fragrance mixtures that can be of either *cis* or *trans* variations of chemicals, or mixtures thereof, including those possessing the compositional note preferences within the scope of the present claims, according to the Genus application teachings of either *Morelli et al.*, *Rhode et al.*, *Burell et al.*, and

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Rhode in view of Burell et al. so as to produce desired end results. Therefore, the rejections of Claims 1-23, as applied to *Morelli et al.*, *Rhode et al.*, *Burell et al.*, and *Rhode in view of Burell et al.* are still retained.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON GRESO whose telephone number is (571)270-7337. The examiner can normally be reached on 0730-1700 Eastern USA.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 571 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James J. Seidleck/
Supervisory Patent Examiner, Art Unit 1796

AJG